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SEP 15 2005

OFFICE OF PETITIONS

In re Application of :
Baekkeskov et al. : DECISION ON APPLICATION
Application No. 09/993,371 : FOR
Filed: November 13, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No.2307AA-043030US:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed May 6, 2005. Applicants submit that the correct patent term adjustment as of the date of allowance is two hundred twenty-five (225) days. In part, Applicants make this assertion on the basis that the Office has failed to issue a patent within 3-years of the actual filing date of the application.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the

request. Patentees may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

As to the application for patent term adjustment at the time of mailing of the notice of allowance, this request is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is one hundred forty-three (143) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On February 4, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 0 days. On May 6, 2005, the instant request for reconsideration was timely filed¹. Applicants assert that the additions to PTA total 382 days, as follows:

- 1) 167 days for Office delay in issuing a first Office action on June 30, 2003;
- 2) 133 days for Office delay in not taking action until June 16, 2004 in response to applicants' response filed October 3, 2003; and
- 3) 82 days for the Office taking in excess of three years to issue the patent, using the date of mailing of the notice of allowance as the end date for this adjustment.

Applicants further assert that the 382 days should be reduced by 157 days for applicant delay, as follows:

- 4) 124 for applicant delay in responding to the Notice to File Missing Parts of Application mailed January 7, 2002;
- 5) 2 days for applicants responding on October 3, 2003 to the Office action mailed June 30, 2003;

¹ PALM records indicate that the Issue Fee was also received on May 6, 2005.

- 6) 31 days for applicants responding on October 18, 2004 to the Office action mailed June 16, 2004.

Applicants' basis for and amounts of adjustment and reduction as set forth in points 1-6 above have been considered. As to point 3 and an adjustment of 82 days, any required decision on the period of adjustment for Office delay in taking more than 3 years to issue the patent is being held in abeyance. The patent should issue with a revised patent term adjustment including any period of adjustment pursuant to § 1.703(b).

As to points 1, 4, and 6, the record includes adjustments and reductions on the bases set forth by applicants. Further, the record agrees with applicants' calculation of a period of reduction of 124 days (point 4). However, the calculation of record for point 1 is 168 days, not 167 days. 168 days is correct, counting the number of days in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a), January 14, 2002, and ending on the date of mailing of an action under 35 U.S.C. 132, June 30, 2003. See 1.703(a)(1). Likewise, the calculation of point 6 is 32 days, not 31 days. 32 days is correct, counting the number of days in the period beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, September 17, 2004, and ending on the date the reply was filed, October 18, 2004. See § 1.704(b).

As to points 2 and 5 above, applicants are correct that the record requires correction of the amounts of adjustment and reduction on these bases. The record establishes that applicants filed an amendment on October 3, 2003, not February 20, 2004. As indicated in point 2, using the proper date of October 3, 2003, a period of adjustment should be entered for Office delay in taking action in response until June 16, 2004. However, this period of adjustment is 134 days, not 133 days, counting the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed, February 4, 2004, and ending on the date of mailing of either an action under 35 U.S.C. 132, June 16, 2004. See 1.703(a)(2). Likewise, using the proper date of October 3, 2003, the entry of a reduction of 143 days for applicant delay in responding to the Office action mailed June 30, 2003 is incorrect. However, this period of reduction is 3 days, not 2

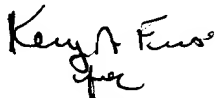
days, counting the number of days in the period beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, October 1, 2003, and ending on the date the reply was filed, October 3, 2003. See § 1.704(b).

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is one hundred forty-three (143) days (168 + 134 days of adjustment - 124 + 3 + 32 days of reduction).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.



Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of updated PAIR screen